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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,676	07/14/2003	Frederic Legrand	05725.1227-00	4116
22852	7590	03/07/2008		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER AHMED, HASAN SYED	
			ART UNIT	PAPER NUMBER
			1618	
			MAIL DATE	DELIVERY MODE
			03/07/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/617,676

Applicant(s)

LEGRAND, FREDERIC

Examiner

HASAN S. AHMED

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 23-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Receipt is acknowledged of applicant's amendment, remarks, and RCE, all filed on 21 December 2007.

* * * * *

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 21 December 2007 has been entered.

* * * * *

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-22 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Dias (U.S. Patent No. 6,540,791) in view of Legrand, et. al. (U.S. Patent No. 6,260,556), further in view of Caes, et. al. (U.S. Patent No. 6,423,306).

Dias teaches a hair bleaching composition and a method of making a hair bleaching composition comprising the polydecene of instant claims 1, 3-5, 18, and 21

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(see col. 23, line 12), the nonionic amphiphilic polymers of instant claim 16 (see col.15, lines 37-48), the peroxygentated salt (perborate) of instant claim 10, the alkaline agent (ammonium salts) of instant claims 13 and 14, and the surfactants of instant claim 17 (see col. 9, lines 52-59). The composition may be in the paste form of instant claims 1, 18, and 21 (see col. 49, line 36).

Dias explains that by combining the disclosed ingredients into one composition, "...stable hair bleaching and/or coloring compositions can be made which are safe and effective for use on mammalian hair and which provide ... (increased) shelf-life and bleaching effect benefits..." See col. 3, lines 34-38.

The Dias reference differs from the instant application in that it does not disclose the particular peroxygenated salts of instant claim 11 or the hydrogen peroxide of instant claims 21 and 22.

Legrand, et. al. teach anhydrous compositions for bleaching keratin fibers (see col. 1, lines 1-13). The disclosed composition consists of, *inter alia*, the sodium persulfate of instant claim 11 (see col. 17, line 6), and hydrogen peroxide (see col. 1, line 19).

The Dias reference differs from the instant application in that it does not disclose the polydecene of claims 1, 3, 18, and 20-22, in which at least 30 carbon atoms are presented in the claimed formula.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make such a composition by incorporating a polydecene compound having at least 30 carbon atoms because the Dias reference teaches clearly

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that polydecene compounds having more than 19 carbon atoms can be used in the composition (*see* col. 23, lines 1-12). Thus, a person of ordinary skill in the art would be motivated to use hydrocarbon polymers having more than 19 carbon atoms, including those claimed, and would expect such a composition to have similar properties to those claimed, absent unexpected results.

The Dias reference differs from the instant application in that it does not disclose the gelling agent of instant claims 1, 6-9, 18, 21 and 22.

Caes, et. al. teach cosmetic compositions for use on hair, including pastes (*see* col. 5, line 60; col. 6, lines 30-39).

The disclosed composition consists of the gelling agent of instant claims 1, 6-9, 18, 21 and 22, including the particular hydrogenated block copolymers of instant claim 9.

Caes, et. al. explain that use of multi-block copolymers in a cosmetic composition provides the benefits of, "...very good adherence to the substrate, flexibility, wearability, good dry time, non tacky, good retention, non transfer, and low migration over time." *See* col. 1, lines 53-56.

While the Dias reference does not explicitly teach all the instant claimed percentages of agents, it would have been obvious to one of ordinary skill in the art at the time the invention was made to determine suitable percentages through routine or manipulative experimentation to obtain the best possible results, as these are variable parameters attainable within the art.

Moreover, generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456; 105 USPQ 233, 235 (CCPA 1955). Applicants have not demonstrated any unexpected or unusual results, which accrue from the instant percentage ranges.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to make an anhydrous paste comprising a peroxygenated salt, an alkaline agent, a polydecene, and a gelling agent, as taught by Dias in view of Legrand, et. al., further in view of Caes, et. al.

One of ordinary skill in the art at the time the invention was made would have been motivated to make an anhydrous paste comprising a peroxygenated salt, an alkaline agent, a polydecene, and a gelling agent for the beneficial effects of stable hair bleaching and/or coloring compositions which are safe and effective for use on mammalian hair and which provide increased shelf-life and bleaching effect benefits, as well as very good adherence to the substrate, flexibility, wearability, good dry time, non tacky, good retention, non transfer, and low migration over time, as explained by Legrand, et. al. and Caes, et. al.

* * * * *

Response to Arguments

Applicant's arguments filed 21 December 2007 have been fully considered but they are not persuasive.

35 USC 103

1. Applicant argues that Dias teaches away from an anhydrous product, "...particularly one with less than 1% water as now recited in the amended claims." See remarks, page 15.

Examiner respectfully submits that Dias teaches water as merely a *preferred* diluent (see col. 4, line 66). Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). See MPEP 2123.

Dias teaches that the diluent concentration may be as low as 5% by weight of the composition (see col. 45, line 16). Furthermore, if water is the diluent, it can be replaced by up to 50% by weight of the total water content (see col. 50, line 41), with the ingredients listed at col. 50, lines 39-44. When these teachings are taken together, Dias discloses a water content as low as 2.5% by weight of the composition. A prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). See MPEP 2144.05.

2. Applicants argue that, "Examiner's reliance on the Woodruff case is improper" since the range in Dias does not overlap with the instantly claimed range, while in the

facts of the *Woodruff* case had overlapping ranges. See remarks, paragraph bridging pages 15 and 16.

Examiner respectfully submits that in the excerpted language, the court was commenting on the following cases: *Gardner v. TEC Sys., Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed.Cir.), *cert. denied*, 469 U.S. 830 [225 USPQ 232] (1984); *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980); *In re Ornitz*, 351 F.2d 1013, 147 USPQ 283 (CCPA 1965); *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955). In order for applicant to conclude that examiner's reliance upon the *Woodruff* case was improper, he would have to show that the cases cited by the *Woodruff* court dealt with overlapping ranges.

Furthermore, the excerpt from *Woodruff* in question was taken from MPEP 2144.05 (III), entitled "Rebutal of *Prima Facie* Case of Obviousness", not MPEP 2144.05 (I) entitled "Overlap of Ranges".

3. Applicants argue that the polydecene range taught by Dias, "...is indeed outside, and significantly lower than, the amount of the at least one polydecene ranging from 15% to 35% by weight of the total weight of the paste as recited in, for example, present claim 1. There is no overlap." See paragraph bridging pages 15 and 16.

While it is true that the range taught by Dias does not explicitly overlap with the instantly claimed range, the instant specification discloses a polydecene concentration as low as 5% (see instant specification, page 8, paragraph 041). As explained above, a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected

them to have the same properties. Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). See MPEP 2144.05.

4. Applicants argue that, "a person of ordinary skill in the art would not expect polydecene ranging from 15% to 35% by weight to be miscible within the aqueous compositions taught by Dias. This difference in concentration ranges of polydecene reflects the fundamental difference between the invention in Dias, which is directed to a bleaching solution, and the present invention, which is directed to an anhydrous paste." Emphasis in original. See remarks, page 16.

Dias explicitly teaches non-aqueous formulations, including cream, gel, foam, mousse, solid, powder, shampoo, mascara, and paste (see col. 49, lines 34-36). Dias explains that, "...it is important that dyeing compositions be in a form which is easy and convenient to prepare and use by the consumer, since the oxidizing agent must remain in contact with the hair for a certain period of time and not run or drip off of the hair, possibly causing eye or skin irritation." See col. 49, lines 28-34; emphasis supplied. Examiner respectfully submits that a person of ordinary skill in the art would expect the claimed polydecene range to be misible in any of the above formulations taught by Dias.

5. Applicants argue that, "...it is the choice of the claimed polydecenes, in contrast to other hydrocarbon oils or fatty esters, which yields the unexpected benefits of hair wit a less greasy feel. Dias provides no suggestion for going through this exercise and no suggestion of the use of an anhydrous paste for bleaching human keratin fibers comprising a polydecene compound having at least 30 carbons in such a high concentration." See remarks, paragraph bridging pages 16 and 17.

Dias teaches non-aqueous formulations of hair dyeing compositions (*see* col. 49, lines 34-36) comprising polydecene compounds having more than 19 carbon atoms (*see* col. 23, lines 1-12) at a concentration of up to 3% by weight of the composition.

Applicant discloses a hair dyeing composition comprising polydecene compounds having at least 30 carbons at a concentration as low as 5% (*see* instant specification, page 8, paragraph 041).

As explained above, a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). *See* MPEP 2144.05.

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Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HASAN S. AHMED whose telephone number is (571)272-4792. The examiner can normally be reached on 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571)272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. S. A./
Examiner, Art Unit 1618

/Humera N. Sheikh/
Primary Examiner, Art Unit 1618